

III. REMARKS

Claim Status

Claims 1-20 are pending in the application. Claims 1, 7-8 and 10-15 have been amended, claims 9 and 16-20 have been cancelled. Claims 21-25 are new.

Claim Amendments

Claim 1 has been amended, *inter alia*, to recite that the claimed composition is essentially nonvolatile and caustic free. Basis for these limitations appears in the specification at paragraph [0003] of the published application. The term "essentially nonvolatile" is defined at paragraph [0022].

Claim 1 has also been amended to include the ratio of component A to component B. Basis for this amendment appears in the published specification at TABLE 1, paragraph [0033].

Claim 1 has been amended from $y = 0$ to 5 to recite that $y = 1$ to 5. Basis for this amendment appears throughout the specification where di and oligoamines are mentioned and all exemplifies amines in TABLE B are di and oligoamines.

Claim Objections - 37 CFR 1.75(c)

Claims 7-12 and 20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim.

The claims have been amended to remove the double dependency thus obviating this ground for objection.

Claim Rejections - 35 USC § 112

Claims 6 and 15-16 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 stands rejected under 35 U.S.C. 112, second paragraph, for containing the phrase "essentially nonvolatile." as rendering the claim vague and indefinite, on the basis that one of ordinary skill in the art would not be able to ascertain the metes and bounds of the term "essentially nonvolatile" and that the specification does not contain guidelines describing what numerical values are encompassed by the phrase "essentially nonvolatile".

Applicant respectfully traverses the ground for rejection and refers the examiner to paragraph [0022] of the published application which states:

[0022] The term "essentially nonvolatile" refers to the characteristic that the substance at issue is essentially of low volatility, or alternatively essentially meets or exceeds one or more of the following volatility criteria, and as such, is considered of a nonvolatile nature: 1) United States Environmental Protection Agency (EPA) Method 24; 2) American Society for Testing Materials (ASTM) Method D 3960; 3) has a vapor pressure .ltoreq.0.1 mm Hg at ambient temperature.

Favorable reconsideration of this ground for rejection is

requested.

Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, for containing the phrase "specifically delineated herein." The term "specifically delineated herein" renders the claim vague and indefinite.

Claim 15 has been amended to remove the offending clause.
Claim 16 has been cancelled

Claim Rejections - 35 USC § 102

Claims 1-6 and 13-19 stand rejected under 35 U.S.C. 102(b) as anticipated by Long, USP 4,873,014.

Long, U.S. Patent No. 4,873,014, discloses a pickling composition comprising a polyalkylene polyamine, such as tetraethylene pentamine (see abstract and col. 2, lines 18-37), a polyglycol, such as polyethylene glycol and polypropylene glycol having molecular weights of 200 and 400 (see col. 2, line 38-col. 3, line 5), hydrochloric acid (see col. 3, lines 31-35), and water (see col. 3, line 35), per the requirements of the instant invention. Specifically, note Examples 1-2.

The examiner asserts that the compositions disclosed in Long would inherently meet the pH requirements of the instant invention, since the compositions disclosed in Long contain all of the required components in the amounts required in the instant claims, absent a showing otherwise.

Applicant respectfully disagrees.

Applicant does not require 30 to 35% hydrochloric acid.

Specifically, claim 2 and claims dependent thereon require a pH of 6 to 8. A composition containing 30 to 35% by weight of HCl does not have a pH of 6-8.

Note also that claim 3 requires a di- or polybasic acid unlike the reference's disclosure of a monobasic acid.

Therefore, instant claims 1-6 and 13-19 are not anticipated by Long, USP 4,873,014 and applicant respectfully requests reconsideration of this ground for rejection.

Claims 1-2, 5-6, 13-17 and 19 stand rejected under 35 U.S.C. 102(b) as anticipated by Belcak et al., USP 3,954,648.

Belcak et al., U.S. Patent No. 3,954,648, discloses a composition for removing enamels, acrylics, epoxys, primers and other coatings from surfaces comprising alkylamines, an alcohol, such as polyethylene glycol and triethylene glycol and adjunct ingredients, such as surfactants, thickeners, sequestrants, and corrosion inhibitors per the requirements of the instant invention.

The examiner neglects to mention that Belcak et al. specifically requires the presence of a caustic agent in the form of an alkali metal hydroxide. This is the old art, as specifically mentioned by applicant at paragraph [0003] of his published application:

"[0003] It has now been surprisingly found that the replacement of the aforementioned volatile organic solvents, volatile amines, and caustics, by a combination of essentially nonvolatile oligomeric

alkylene glycol(s) and/or certain of their mono ethers, and/or ether hydroxy esters, (cf. Formula A), and (optionally partially acid neutralized) di/oligo amines (cf. Formula B), ..."

Belcak et al.'s solutions are anhydrous, i.e. they are solvent based [col. 1. lines 53-56] and require one member from each of three chemical groups [col. 1, lines 57-59] of which alkali metal hydroxides are one.

Not only does applicant's invention exclude the use of caustics, it is a water based system [see Example 1].

Thus, applicants compositions are different [no caustic] and they are used differently [in water].

As the compositions are different and the use environment is different, applicant respectfully requests favorable reconsideration of this ground for rejection.

Claims 1-2, 5-6, 13-17 and 19 stand rejected under 35 U.S.C. 102(b) as anticipated by Nagoshi et al., USP 5,958,298.

As stated by the examiner, Nagoshi et al., USP 5,958,298, disclose an anti-corrosive draining agent comprising a glycol ether, an amine compound and adjunct ingredients, such as surfactants per the requirements of the instant invention.

Applicant respectfully traverses this ground for rejection.

Nagoshi et al. disclose a rinsing solution of polyoxyalkylene alkyl ether and amine where the ratio of the two components is from 1 to 20% ether and from 80 to 99% amine. [Abstract, col. 2, lines 36-40 and lines 62-67 and Examples 1-17. Nagoshi et al. find this ratio satisfactory for their purpose, which is different from applicants. Nagoshi et al. disclose anti-corrosive draining agents, not applicant's VOC free strippers.

Applicants disclose the operative ratios of components of their compositions in Table 1 where the "A" components are the glycols and/or ethers and the "B" components are the di/oligoamines.

Formulation	Amount "A" Component	Amount "B" Component	% "A"	% "B"
1C	17	8	68	32
1D	16	7	70	30
1F	11	8	58	42
1G	10.5	12	47	53
1H	12	11	52	48
1J	15	11.5	57	43
K	8.7	8.6	50	50
1L	7.8	7.5	51	49

Range A = 47-70%

Range B = 30-53%

Applicants have amended claim 1 to recite the ratio set forth in the instant specification. As the compositions disclosed in Nagoshi et al. do not contain the amounts of the components required in the instant claims, Nagoshi et al. do not anticipate the present claims.

Claim Rejections - 35 USC § 103

Claims 1-6 and 13-19 stand rejected under 35 U.S.C. 103(a) as obvious over Long, USP 4,873,014.

The examiner argues that it would have been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

Applicant respectfully disagrees.

Applicant does not require 30 to 35% hydrochloric acid.

Specifically, claim 2 and claims dependent thereon require a pH of 6 to 8. A composition containing 30 to 35% by weight of HCl does not have a pH of 6-8.

Note also that claim 3 requires a di- or polybasic acid unlike the reference's disclosure of a monobasic acid.

Since Long teaches a composition requiring a large proportion of a monobasic acid and applicant specifically excludes the use of a monobasic acid [paragraphs 17, 23], viz.

"However the (optionally employed) neutralizing acids preferred for use in the practice of this invention are di and/or poly basic as opposed to monobasic varieties of either inorganic or organic acids."
[paragraph 0023]

Specific examples of the acids utilized by applicant are

disclosed in Example 1, TABLE 1 and TABLE D.

Long discloses the use of a different composition, one containing hydrochloric acid, a monobasic acid, in major amounts, for a different use [steel pickling] than applicant's [coating stripping]. There is nothing in Long to lead a skilled practitioner to substitute a different acid [which is only optional in applicant's composition] in a minor amount for a different purpose.

Applicant believes the examiner has not made out a prima facie case and respectfully requests reconsideration.

Claims 1-2, 5-6, 13-17 and 19 stand rejected under 35 U.S.C. 103(a) as obvious over Belcak et al., USP 3,954,648.

The examiner argues that it would have been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

Applicant traverses this ground for rejection.

Belcak et al.'s solutions are anhydrous, i.e. they are solvent based [col. 1. lines 53-56] and require one member from each of three chemical groups [col. 1, lines 57-59] of which alkali metal hydroxides are one.

Applicant's invention excludes the use of caustics.

As set forth above, applicants have "surprisingly found that the replacement of the aforementioned volatile organic solvents, volatile amines, and caustics, by a combination of

essentially nonvolatile oligomeric alkylene glycol(s) and/or certain of their mono ethers, and/or ether hydroxy esters, (cf. Formula A), and (optionally partially acid neutralized) di/oligo amines (cf. Formula B), ..." [paragraph 0003] emphasis supplied

Also, as set forth above Belcak et al. specifically states that theirs is an anhydrous system, i.e. their compositions are solvent based [col. 1. lines 53-56].

Further, Belcak et al. require one member from each of three chemical groups [col. 1, lines 57-59] of which alkali metal hydroxides are one.

Thus, applicants compositions are different [no caustic], they are used differently [in water] and Belcak et al. specifically teach away from applicant's compositions [anhydrous is specifically required by Belcak et al.].

Since the reference teaches different compositions and specifically teaches away from applicants water based compositions, there is nothing to lead a skilled practitioner to the present invention.

Applicant believes the examiner has not made out a prima facie case and respectfully requests reconsideration.

Claims 1-2, 5-6, 13-17 and 19 stand rejected under 35 U.S.C. 103(a) as obvious over Nagoshi et al., USP 5,958,298.

The examiner argues that it would have been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the

claimed proportions for the same utility.

Applicant traverses this ground for rejection.

First, Nagoshi et al. do not teach the same utility. Nagoshi et al. disclose anti-corrosive draining agents, not applicant's VOC free strippers.

Second, Nagoshi et al., do not teach the same proportions as the amended claims. Nagoshi et al. disclose a rinsing solution of polyoxyalkylene alkyl ether and amine where the ratio of the two components is from 1 to 20% ether and from 80 to 99% amine. Applicant discloses 47-70% glycols and/or ethers and 30-53% amine.

Since the reference teaches different compositions utilized for different purposes, there is nothing to lead a skilled practitioner to the present invention.

Applicant believes the examiner has not made out a prima facie case and respectfully requests reconsideration.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 50-3894.

Respectfully submitted,

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